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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,875	01/12/2001	Jerome L. Krupa	P1329USA	2537

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EXAMINER	
HENDERSON, MARK T	

ART UNIT	PAPER NUMBER
3722	

DATE MAILED: 03/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/759,875	Jerome L. Krupa
Examiner	**Art Unit**
Mark Henderson	3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-47 is/are pending in the application.

4a) Of the above, claim(s) 15-47 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-14 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on Jan 12, 2001 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, are drawn to a label product, classified in class 283, subclass 74.

II. Claims 15-27, are drawn to a combination of a bottle and label product, classified in class 206, subclass 459.

III. Claims 28-47, are drawn to a system and method of making the bottle and label, classified in class 235, subclass 462.49.

1. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination (bottle with label) as claimed does not require the particulars of the subcombination (label) as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the subcombination as claimed does not require the particulars of the combination as claimed because subcombination does not require containment of pharmaceuticals or body fluids (as evidenced by claim 21 and 22). The combination has separate utility such as a bottle itself having a descriptive label.

2. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as affixing the label through the use of a shrink-fit process wherein the label is wrapped around a container, then heated to conform to the exterior shape of the container.

3. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be

used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as reading the indicia on a list an comparing it with the indicia on the bottle.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Attorney Brian Rupp on March 21, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference "34" as stated on page 11 is not shown in the drawings. Correction is required.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "76" and "36" have both been used to designate "a bar code reader". Correction is required.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "36" has been used to designate both a "label" and a "bar code reader". Correction is required.

Specification

9. The disclosure is objected to because of the following informalities: On page 13, lines 12 and 13, It is not understood what is meant by the phrase "second portion 62 vertically aligns with the bar code 64 with the bar code 38 on the container 10". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-5, 7-9, and 11-13, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton-Steidle et al in view of De La Huerga (PAP 2001/0017817).

Horton-Steidle et al discloses in Fig. 1A and 3, a label (212) for a container (any type) which can have another symbol label (214), wherein the label (212) has a rectangular first portion (first half of the label) having an outer edge, and a rectangular second portion (second half of the label) in which indicia (bar codes, as stated in Col. 4, lines 1-10) is inscribed on the second portion and the symbol which can be electronically read.

However, Horton-Steidle does not disclose: a second portion extending out and away from a side outer edge of the first portion; a second portion which extends from a corner of the first portion and out from a top side; wherein the symbol and label are aligned vertically; and wherein the indicia is a checksum of the symbol.

De La Huerga discloses in Fig. 16, 17, a label (50) having a first portion (527) with an outer edge and a second portion (529) extending out and away from the outer edge.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Horton-Steidle et al's label and to include a label having a first portion and an extended second portion with electronically read indicia as taught by De La Huerga for the purpose of providing the electronically readable indicia to be easily recognizable and distinct from the main label portion.

In regards to **Claims 3 and 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the second portion at any desirable location on the first portion, an align the symbol and the label indicia in any direction, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claims 12 and 13**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any type of indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

11. Claims 6, 10 and 14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton-Steidle et al as modified by De La Huerga and further view of Seidl (DE 19807232).

Horton-Steidle et al and De La Huerga disclose a label comprising all the elements as claimed in Claim 1 and as set forth above. However, Horton-Steidle and De La Huerga do not disclose a label and symbol (label) which can be read simultaneously by a bar code reader and in which the labels second portion can cover the symbol.

Seidl discloses in Fig. 4, a symbol (2), and a label (1) which partially cover the symbol (2), and in which both the symbol and the second portion indicia can be read simultaneously by a bar code reader.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Horton-Steidle and De La Huerga label to include a symbol and a label which can be simultaneously read as taught by Seidl for the purpose of linking various forms of information.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Rotermund, Petrick et al, Small, Merry et al, Sullivan et al, Gelsinger et al, Jahier et al, Mangini et al, Tung et al, Foote et al, Petrick et al, Petrick, Sasso, Sallenbach, and Erber et al disclose a label for a container.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

March 25, 2002

A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
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